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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/603,207 | 06/25/2003 | Richard Douglas Kemp | 3524/170 | 2681 |
| 29858 | 7590 | 06/28/2006 | EXAMINER PHAM, KHANH B | |
| BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022 | | | ART UNIT 2166 | PAPER NUMBER |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/603,207 | KEMP, RICHARD DOUGLAS | |
| | Examiner | Art Unit | |
| | Khanh B. Pham | 2166 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 13-15,25,26,37-41,43 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,16-24,27-36,42,44 and 46-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/5/04, 3/9/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with partial traverse of invention I in the reply filed on April 3, 2006 is acknowledged. The traversal is on the ground(s) that claims 13-15 and 37-41 should be grouped with the Group I. This is not found persuasive because the invention of group I drawn to database query processing, classified in class 707, subclass 3; whereas claims 13-15 and 37-41 are not directed to system and method for retrieving data from a database in response to a user request, but directed to system and method for displaying different type of data on a display device, classified in class 715, subclass 700. The step of "automatically updating displayed information" recited in claims 13 and 37 do not require processing of query to a database recited in group I.

The requirement is still deemed proper and is therefore made FINAL.

- Claims 1-12, 16-24, 27-36, 42, 44 and 46-55 are pending in this Office Action.
- Claims 13-15, 25-26, 37-41, 43 and 45 are withdrawn from further consideration as being drawn to a non-elected invention.

Claim Objections

2. **Claims 10, 30, 36 are objected to** because of the following informalities:

- Claim 10, line 2: "the information" should be deleted.
- Claims 30, 36, line 3: "an" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-12, 16-24, 27-36, 42, 44 and 46-55 are rejected under 35**

U.S.C. 102(e) as being anticipated by Lee et al. (US 6,839,707 B2), hereinafter "Lee".

As per claim 1, Lee teaches at Fig. 1 a system for providing legal information, the system comprising at least one computer, at least one database associated with the at least one computer for storing information related to a plurality of legal topics, and programming stored on a computer readable medium or media that cause the at least one computer to:

- "access within the at least one database information related to at least one legal topic, in response to a request received from a user-accessible terminal coupled with the system" at Col. 2 lines 14-22;
- "cause the accessed information to be displayed on a display device associated with the terminal from which the request was received, the information tabulated according to a classification comprising at least two types" at Figs. 6-17.

As per claim 2, Lee teaches the system of claim 1, wherein "the at least two types comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, and news" at Figs. 6-8.

As per claim 3, Lee teaches the system of claim 1, wherein the displayed information is tabulated according to a classification by displaying information related to each type in a separate display window" at Fig. 6-8.

As per claim 4, Lee teaches the system of claim 3, wherein "the classification comprises at least two of the types: "administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 6-8.

As per claim 5, Lee teaches the system of claim 3, wherein "the classification comprises at least the types: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 6-8.

As per claim 6, Lee teaches the system of claim 1, wherein "the legal topic is designated by a user to the terminal from a plurality of legal topics comprising at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and personal property; communications; media; constitutional; construction; contracts; criminal; education; employment; labor;

Lee teaches the system of claim 1, wherein "the legal topic is designated by a user to the terminal from a plurality of legal topics comprising at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and personal property; communications; media; constitutional; construction; contracts; criminal; education; employment; labor;

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entertainment; gaming; sports; environmental; estates, trusts, and wills; family; government; elections and politics; government benefits; government contracts; government administration; state government; local government; health; human rights; immigration; insurance; intellectual property; copyrights; patents; trademarks; international; international trade; internet; litigation; litigation administration; appellate procedure; civil procedure; damages and remedies; evidence; mergers and acquisitions; military; natural resources; energy; native populations; professions and occupations; professional licensing; professional responsibility; products liability; real property; science and technology; securities; US federal taxation; state taxation; international taxation; torts; transportation; and workers' rights" at Figs. 6-17.

As per claim 7, Lee teaches the system of claim 1, wherein "the system comprises programming stored on a computer readable medium or media that causes the at least one computer to further automatically:

- "access within the at least one database new information responsive to the request" at Col. 2 lines 7-22 and Fig. 6;
- "cause the accessed new information to be displayed on a display associated with the terminal from which the request was received, the information tabulated according to a classification" at Fig. 6.

As per claim 8, Lee teaches the system of claim 1, wherein "the system comprises programming stored on a computer readable medium or media that causes the at least one computer to automatically and periodically:

- "access at least one database to determine whether new information responsive to the request is stored within the database" at Col. 2 lines 7-22 and Fig. 6;
- "if new information responsive to the request is stored within the database, cause the new information to be displayed on a display associated with the terminal from which the request was received, the information tabulated according to a classification" at Fig. 6.

As per claim 9, Lee teaches the system of claim 1, wherein the system comprises programming stored on a computer readable medium or media that causes the at least one computer to automatically and continually:

- "access at least one database to determine whether new information responsive to the request is stored within the database" at Col. 2 lines 7-22 and Fig. 6;
- "if new information responsive to the request is stored within the database, cause the new information to be displayed on a display associated with the terminal from which the request was received, the information tabulated according to a classification" at Fig. 6.

As per claim 10, Lee teaches the system of claim 1, comprising "a plurality of databases for storing the information related to legal topics, wherein the information is

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stored in separate databases according to the legal topics to which information relates” at Col. 1 line 60 to Col. 2 line 6.

As per claim 11, Lee teaches the system of claim 1, comprising “plurality of databases for storing the information related to legal topics, wherein the information is stored in separate databases by type according to the classification” at Col. 5 lines 35-50 and Fig. 3.

As per claim 12, Lee teaches the system of claim 1, comprising a plurality of databases for storing the information related to a plurality of legal topics, the information provided by a plurality of sources, wherein the information is stored in separate databases according to the sources that provided the information” at Col. 9 lines 25-45.

As per claim 16, Lee teaches at Fig. 1 a system for providing legal information, the system comprising at least one computer, at least one database associated with the at least one computer for storing information related to a plurality of legal topics, and programming stored on a computer readable medium or media that causes the at least one computer to:

- display on a display device coupled to a user-accessible terminal coupled with the system items of a plurality of different types of legal information, the information tabulated according to a classification comprising at least two types” at Fig. 6;

- “access within at least one database, in response to a request received from the user-accessible terminal, content information associated with a document identified by an item of the displayed information” at Col. 8 lines 35-48 and Fig. 6; and
- “cause the accessed content information to be displayed on the display device associated with the terminal from which the request for content information was received” at Fig. 7.

As per claim 17, Lee teaches the system of claim 16, wherein “items identifying the documents comprise selectable links and the request is generated by a user selecting a selectable link using an input device coupled with the user-accessible terminal” at Col. 8 lines 35-48.

As per claim 18, Lee teaches the system of claim 16, wherein “the displayed content information comprises a complete version of a document” at Col. 7 lines 5-30.

As per claim 19, Lee teaches the system of claim 16, wherein “the displayed content information comprises an abbreviated version of a document” at Col. 5 lines 25-35.

As per claim 20, Lee teaches the system of claim 19, wherein “the abbreviated version of a document comprises a summary of a document” at Col. 7 lines 5-30.

As per claim 21, Lee teaches the system of claim 19, wherein "the abbreviated version of a document comprises at least one redacted portion of a document" at Col. 5 lines 25-35 and Col. 7 lines 5-30.

As per claim 22, Lee teaches the system of claim 16, wherein "the displayed content information comprises at least a partial image of a document" at Col. 7 lines 5-30.

As per claim 23, Lee teaches the system of claim 16, wherein "the accessed content information is displayed in a different display window than the displayed information items" at Figs. 6-17.

As per claim 24, Lee teaches the system of claim 16, wherein "the accessed content information is displayed on a different monitor screen than the displayed information items" at Col. 7 lines 35-45.

As per claim 27, Lee teaches at Figs. 1-3 a system for providing legal information, the system comprising at least one computer, a plurality of databases associated with the at least one computer for storing information related to a plurality of legal topics, and programming stored on a computer readable medium or media, wherein:

- "at least one of the databases is accessible in response to requests received from terminals having a general authorization for access to the system" at Col. 4 lines 53-55, and
- "at least a second of the databases is accessible in response to requests received from terminals having a specific authorization" at Col. 6 lines 5-35;
- "and the programming causes the at least one computer to: access, in response to a request received from a user-accessible terminal coupled with the system, information related to at least one legal topic in at least one database accessible by terminals having the general authorization" at Fig. 5;
- "and in at least the second database accessible by terminals having the specific authorization; and cause the accessed information to be displayed on a display device associated with the terminal from which the request was received, the information tabulated according to a classification comprising at least two types" at Fig. 6.

As per claim 28, Lee teaches the system of claim 27, wherein "the second database accessible in response to requests received from terminals having the specific authorization is associated with the user-accessible terminal from which the request is received" at Col. 6 lines 5-35.

As per claim 29, Lee teaches the system of claim 27, wherein "the programming stored on a computer readable medium or media that causes the system to access

information responsive to the request in at least one database accessible by terminals having a general system authorization and in at least one database accessible by terminals having a specific authorization is stored on a computer readable medium or media associated with the terminal from which the request is received" at Col. 6 lines 5-35.

As per claim 30, Lee teaches a method of processing legal information, the method comprising:

- "assigning to each of a plurality of documents received from at least one information source ~~an~~ comprising information relating to a plurality of legal topics at least one identifier associated with (a) at least one of the legal topics to which the document relates and (b) at least one of a plurality of classes of information within the at least one legal topic, according to a type of information included within the document" at Col. 10 lines 34-44 and Fig. 12;
- "formatting the received documents according to a protocol; storing the formatted documents in at least one database" at Col. 9 lines 10;
- "using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user-accessible terminal for information related to at least one of the plurality of legal topics" at Col. 10 lines 44-65;
- "causing information associated with the identified documents to be displayed on a display associated with the user-accessible terminal from which the request

was received, the information tabulated according to the topics and classes assigned to the documents with which the information is associated" at Col. 10 line 65-67.

As per claim 31, Lee teaches the method of claim 30, wherein "documents are received from a plurality of sources" Fig. 1.

As per claim 32, Lee teaches the method of claim 30, wherein "documents are stored in a plurality of databases" at Col. 9 lines 3-23.

As per claim 33, Lee teaches the method of claim 32, wherein "the documents are stored in the plurality of databases according to at least one of: the topics assigned to the documents, the classes assigned to the documents, and the sources of the documents" at Col. 9 lines 3-43.

As per claim 34, Lee teaches the method of claim 30, comprising: "checking formatted documents for compliance with a document receiving protocol; and generating a notice of defects automatically upon determination that a checked document does not comply with the protocol" at Col. 9 lines 55-65.

As per claim 35, Lee teaches the method of claim 34, comprising "automatically resubmitting the non-complying document for reprocessing" at Col. 9 lines 55-65.

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Claims 36, 42, 44, 46-49 recite similar limitation as discussed above and therefore rejected by the same reasons

As per claim 50, Lee teaches at Fig. 1-3 a system for providing legal information, the system comprising at least one computer, at least one database associated with the at least one computer for storing information related to a plurality of legal topics, and programming stored on a computer readable medium or media that causes the at least one computer to:

- “access within the at least one database information related to at least two of a plurality of legal topics and a plurality of types of information within the plurality of topics, in response to a request received from a user-accessible terminal coupled with the system” at Figs. 14-16;
- “and cause the accessed information to be output to a device in accordance with a designation received from the terminal from which the request was received, the information comprising identifiers for tabulation, in accordance with a designation received from the terminal from which the request was received, in accordance with a classification comprising the at least two of the plurality of topics and the plurality of types” at Fig. 17.

As per claim 51, Lee teaches the system of claim 50, wherein “the device is a memory controlled by a processor associated with the at least one database” at Col. 5

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lines 25-35.

As per claim 52, Lee teaches the system of claim 50, wherein "the device is a memory designated by the terminal from which the request was received" at Col. 5 lines 25-35.

As per claim 53, Lee teaches the system of claim 50, wherein "the device is a memory associated with an electronic mail address" at Col. 4 lines 20-30.

As per claim 54, Lee teaches the system of claim 50, wherein "the device is at least one of a display, a printer, and a non-volatile memory" at Col. 5 lines 25-35.

As per claim 55, Lee teaches the system of claim 50, wherein "the device is an output device associated with at least one input device for interactive control of the output of the information to a display memory" at Col. 5 lines 25-35 and Figs. 6-17.

Conclusion

5. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (571) 272-3574 for faster service.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Examiner
Art Unit 2166

June 20, 2006

